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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

Ferr - 004

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on _____

Signature _____

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Application Number

101765,104

Filed

1/28/2004

First Named Inventor

Richard D. Ferris

Art Unit

3711

Examiner

Blau

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

applicant/inventor.

assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

attorney or agent of record. 33,621
Registration number _____

attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____

Signature

John L. Welsh

Typed or printed name

703 900 1122

Telephone number

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

*Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Serial No. : 10/765,106

Applicant : Richard D. Ferris

Filed : 01/28/2004

Group Art Unit: 3711

Examiner : Blau

Docket No. : FERR-004

Customer No.: 021884

Title : HANDLE CONFIGURATION FOR A PUTTER TYPE GOLF CLUB

Mail Stop Non-Fee Amendment
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF

Sir:

Applicant has set forth a unique alignment system for putters which is neither disclosed, taught nor shown in the prior art. The claimed alignment system can be found in all claims and generally requires first and second perpendicular intersecting alignment lines on the butt end of the handle. The combination of references cited in the Office Action fails to teach, individually or when combined, the claimed intersecting lines on the end of a golf club handle.

Since all of the claims include the alignment system limitations, all of the rejections set forth in the Office Action have relied upon Radakovich in combination with Takeuchi to teach Applicant's alignment system. It is Applicant's opinion all of these rejections are improper as Radakovich, when

combined with Takeuchi, fails to meet all of the claimed limitations. In addition to not disclosing the claimed invention, Radakovich and Takeuchi are focused upon different concepts relating to golf clubs, and in the Applicant's opinion are, therefore, not obvious to combine.

The alignment system in Radakovich is for sighting a club relative to a target and not aligning the club relevant to the ball which is the purpose of Applicant's claimed alignment system. The alignment system in Takeuchi is for fitting the grip on the rear portion of the club shaft so that a fitting angle of the grip relative to a club face is accurate and easily adjusted. Thus the alignment systems of Applicant, Radakovich and Takeuchi are all for different purposes.

With regard to Radakovich, the so-called first alignment line 48 (Fig. 5) is not perpendicular to the unidentified boundary line, nor is it perpendicular to arrow 46. There is no disclosure in Radakovich as to a boundary line, structure and/or function. Thus, the Office Action merely assumes the boundary line is parallel to the ball striking face, as Radakovich does not teach this. Radakovich at best teaches a sighting device with meeting lines 92 and 94 (Fig. 4), but they do not intersect to form four angles as claimed. The "T" formed in Radakovich is to assist the golfer in sighting down the fairway as he or she positions himself to strike a golf ball and does not include two lines intersecting to form four angles. Therefore, this reference alone cannot meet the limitations of claims 1 and 11.

To overcome the major shortcomings of Radakovich, the Office Action suggests that it would be obvious to replace the "T" of Radakovich with a cross as claimed by Applicant in view of the teaching of Takeuchi. However, Takeuchi also fails to teach intersecting lines. The Examiner relies upon Takeuchi to teach "alignment lines for grip positioning on a shaft being on a flat surface of a grip and being indicia (Fig. 5, Col. 4, Lns. 11-16) filling up the entire length and width of a grip top flat surface except the center." The language of Col. 4., lines 11-16 reads as follows: "The graduations 5

may be either grooves defined in or ridges formed on the rear end surface 3. The grooves or ridges of the graduations 5 may be colored with an applied paint. Of course, the graduations 5 may be formed with markings written with a color paint on the rear end surface 3 of the grip 1.” Upon reviewing this language, Fig. 5 of Radakovich, the entire specification and drawings of Takeuchi, Applicant can find no teaching of intersecting lines. Filling up the entire length and width with indicia is not what Applicant has claimed. Applicant claims intersecting lines forming 4 angles and neither Radakovich nor Takeuchi show or teach intersecting lines. The Examiner has, therefore, failed to set forth a *prima facie* rejection. The Examiner’s logic that Takeuchi shows alignment lines on both halves of a grip end and that Takeuchi would not need to have alignment lines on both halves fails to address the claimed limitation of intersecting lines forming 4 angles.

The Office Action overlooks the fact neither of these references disclose or suggest intersecting lines forming four angles as alignment indicia on the butt end of a putter or, for that matter, any type of golf club. The dictionary definition of intersecting recited by the Examiner is deemed moot as Applicant clarified his definition by including the language to form 4 angles.

It is Applicant’s opinion these two references aren’t even combinable and, even if somehow combined, don’t result in the claimed invention. The motivation for combining as proposed by the Examiner makes no sense and is unsupported by both the prior art and what is known by those skilled in the golf industry. The sighting device and lines of Radakovich do form indicia which take up the entire length, width and center of a grip top flat surface. As such, how and why does Takeuchi need to teach Radakovich to have the alignment lines being indicia taking up the entire length, width and center of a grip top flat surface to minimize the number of parts needed for a grip and in order to be more visible? Radakovich indicia fills up as much of the butt end of the club as does Takeuchi, so

Takeuchi is teaching Radakovich what he already knew. Again, neither knew to form intersecting lines as claimed and intersecting lines would destroy the invention of Takeuchi. Takeuchi does show lines 5a, 6, 7 and 8 on the end of a golf club handle, but none of these lines intersect. In fact, Takeuchi has no desire for the indicia lines to intersect as intersecting lines would be contrary to Takeuchi's invention. The length of Takeuchi's lines are different for a reason, this is so one can easily distinguish the angular intervals when adjusting the grip's position. For example, short lines 8 indicate 11.25 degrees and slightly longer lines 7 indicate 22.5 degrees and long lines 6 indicate 45 degrees and lines 5a function as reference lines. When fitting the grip of Takeuchi on a shaft, the angle of the grip can be easily determined by knowing the distinction between gradation lines. However, if the lines intersected they would no longer function as gradations as the lines would not be readily distinguishable from one another.

Modifying Radakovich as suggested in the Office Action would also destroy the invention contemplated by Radakovich. That is, converting the sighting member into indicia lines statically affixed to the butt end as proposed would render the device inoperative, as the user would no longer be able to simply adjust the device for sighting at a desired loft. As one can surely appreciate, the loft required to hit a target is not the same for every golf shot.

Specifically, the cross of the present invention is designed to provide the golfer with both forward and rearward alignment as he or she stands over a putt. This assists the golfer in properly aligning both the back swing and the forward swing during his or her putt; both being critical to proper putting. In contrast, Radakovich is only concerned with sighting down the fairway in a forward direction. As such, Radakovich only provides a "T". The embodiment shown in Figure 5 shows a sighting device where the rear portion of the sighting device is blackened out. This appears to be

designed so that the attention of the golfer is always directed in a forward direction. Similarly, Figure 4 employs a “T” with nothing along the backside thereof. Once again, this is designed to provide the golfer with forward facing sight to direct a golfer’s eyes in the forward direction. Thus, by providing a cross on Radakovich, the golfer would not be solely directed in a forward direction down the fairway, but would be directed to look in both a rearward and a forward direction. This would destroy or at least hinder the purpose of the sighting device disclosed by Radakovich. As such, it is Applicant’s opinion this assertion is improper and the rejection should be withdrawn.

Applicant has also claimed the unique shape of his handle and the proposed combination of 4 different references Cacicedo, Bloom, Eberle or Dishner fail to even produce Applicant’s claimed shape. The grip in Cacicedo is tapered. The grip in Bloom is tapered and has a larger cross-section at its upper end than at its lower end. The grip in Eberle is neither elliptical nor oval and the grip in Dishner is not oval it is circular with opposing flattened surfaces terminating before reaching either the top or bottom of the grip. Therefore, any combination of these references fails to meet the claimed shape of applicant’s handle.

Claims 1-15 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 of U.S. Patent No. 6,723,001. This rejection is deemed improper and should be withdrawn, as all of the pending claims include alignment system limitations not found in the claims of the ‘001 patent. This limitation is patentably distinct over the shape that was claimed in claims 1-5 of U.S. Patent No. 6,723,001.